

#35

Docket No. CITI0080

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the U.S. Application of

Cris T. PALTENGHE, et al.

Group Art Unit: 3621

U.S. Serial No.: 09/190,727

Examiner: Hayes, J.

Filed: November 12, 1998

For: (Amended Title) METHOD AND SYSTEM FOR INFORMATION STORAGE

APPEAL BRIEF

Commissioner for Patents
U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop **Appeal Brief - Patents**
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

This is an Appeal Brief under 37 C.F.R. § 1.192 in connection with the decisions of the Examiner in a Final Office Action dated June 24, 2003 (6/04/03). Each of the topics required by Rule 192 is presented herewith and is labeled appropriately.

(1) Real Party In Interest

The real party in interest is Citicorp Development Center, Inc.

(2) Related Appeals And Interferences

There are no other appeals or interferences related to this case.

(3) Status Of Claims

Claims 22-24 are pending and rejected. Claims 22-24 are hereby appealed.

(4) Status of Amendments

There are no outstanding amendments.

(5) Summary Of The Invention

The present invention is directed to a system and method for the selective organization, access to and use of personal data. The system may include a server having data storage capability for storing different types of personal data in distinct data stores , i.e., an “information bank”, such that the information may be efficiently used by the consumer and by institutions which the consumer has authorized to access the data. Page 3, lines 1-6. In accordance with the invention, the consumer’s information may be made available through such server, thereby allowing convenient “universal” access to the consumer’s personal information. Page 4, lines 28-31. The present invention will enable the establishment of a trusted third party service to market demographic and other valuable marketing type information to manufacturers, distributors, and other marketing concerns, while protecting an individual’s identity. Fuzzy logic matching is used to match merchant and consumer, on an anonymous basis so that neither knows the identity of the other, and allow consumers to search, shop, and negotiate anonymously, with only items that match their interests being brought to their attention by the service. Page 7, lines 19-25.

(6) Issues

a) Whether the Examiner’s rejection of claims 22 and 24 under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al. (U.S.P. No. 5,794,210) in view of O’Neil et al. (U.S.P. No. 5,987,440) is proper.

b) Whether the Examiner's rejection of claim 23 under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al. and O'Neil et al. in further view of Low et al. (U.S.P. 5,420,926) is proper.

(7) Grouping of Claims

Claims 22-24 stand or fall together for purposes of this appeal.

(8) Arguments

Objection to the Title of the Invention

Per the Examiner's suggestion, the title of the present application will be changed to "METHOD AND SYSTEM FOR ANONYMIZING PURCHASE DATA" once the application is placed in condition for allowance.

The rejection of claims 22-24 under 35. U.S.C. § 103(a) as being unpatentable over Goldhaber et al. (U.S.P. No. 5,794,210) in view of O'Neil et al. (U.S.P. No. 5,987,440) and

Lowe et al. (U.S.P. 5,420,926) is not proper

As stated in the Response to Office Action dated 4/10/03, the rejection of claims 22-24 and 24 under 35 USC 103(a) as being obvious over Goldhaber et al. in view of O'Neil et al. is respectfully traversed for at least the following reasons:

Claim 22 recites, among other patentable features, the combining and anonymizing steps being performed independently of any input by the first or second consumer. The PTO asserts that the anonymizing step is performed independently of any inputs from the consumers as cited

in col. 13, lines 34-55 of Goldhaber et al. However, the cited section of Goldhaber et al., particularly, col. 13, lines 34-40, teaches that the customer *does provide inputs* as to “whether or not to make [his or her contact information] available to advertisers” and that the customer “will probably want to make the [his or her] profile available while keeping [his or her] name and address secret.” Furthermore, O’Neil et al. does not cure such deficiencies because as cited by the PTO in col. 13, line 65 to col. 14, line 14, the features of the system disclosed in O’Neil et al. are user-driven based on user (consumer) input as well. For instance, in col. 14, lines 1-3, O’Neil et al. discloses that its system is used to search all the E-PIA members to find those *that have expressed an interest in purchasing a car* and create a list of all members meeting the necessary criteria. Such disclosure implies that inputs are required from members.

Yet, in the Final Office Action dated 6/24/03 the Examiner maintained the claim rejection by citing col. 6, lines 24-50 of Goldhaber et al. and asserting that,

“Goldhaber [et al.] discloses a database of digitally stored electronic demographic profiles of potential viewers to advertisements and further indicates that many businesses keep profiles of customer’s interests and transactions by tacking the customers purchases independent of any input from the customer and wherein the profiles are kept private (Col. 6, lines 24-50). Thus, Goldhaber et al[.] teach that the demographic profiles are collected independent of nay specific input from the customer and are anonymized by keeping them private (pseudonymous). The inputs provided by the customer are used to determine how to handle and distribute this information to other parties, but not whether or not the information is anonymized.”

The undersigned representative respectfully disagrees with the Examiner’s assertion. It is respectfully submitted that Goldhaber et al. must be reviewed as a whole to obtain the proper context of such disclosure. Thus, in col. 6, lines 24-50 Goldhaber et al. disclose a system that “protects member privacy while at the same time maintaining the personal information files that permit specialized targeting of ads.” Col. 6, lines 28-31. In view of col. 13, lines 34-40,

Goldhaber et al. achieves the aforementioned *member-privacy* objective by allowing members to control what information in their profiles can be made available to other parties, such as advertisers. Col. 13, lines 34-40. In other words, members *must provide inputs* to preserve their anonymity and protect their privacy, wherein such inputs are actually used to determine how to handle and distribute members' personal information to other parties (which is the whole point of anonymizing the personal information in Goldhaber et al., and such determination and anonymizing functions cannot be separated as asserted by the Examiner). This is in contrast to the claimed invention, wherein a consumer's purchase data is kept anonymized *independently of any input* from the consumer.

Claim 23 is also patentable over the combination of Goldhaber et al. and O'Neil et al. for similar reasons, and Low et al. do not cure such deficiencies.

Claim 24 is also patentable over the combination of Goldhaber et al. and O'Neil et al. for similar reasons.

Claims 22-24 stand or fall together with regard to the rejection under 35 USC §103(a) as being obvious over Goldhaber et al. in view of O'Neil et al. and Low et al. for purposes of this appeal. For the reasons stated above, it is respectfully requested that the Board recognize the deficiencies in the Examiner's rejection of the claims, reverse the Examiner's rejection, and allow claims 22 and 24.

Conclusion

For at least the reasons given above, the rejections of claims 22-24 are improper. It is respectfully requested that such rejections by the Examiner be reversed and claims 22-24 be

allowed. Attached below for the Board's convenience is an Appendix of claims 22-24 as currently pending.

Respectfully submitted,

Date:

6/23/2004

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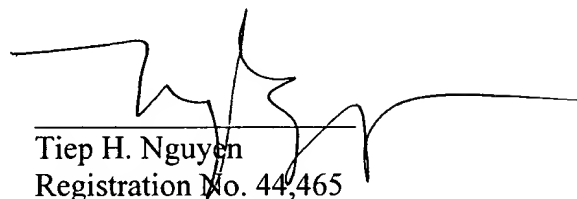
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(9) Appendix

22. A method of transmitting purchase data in a database concerning a first consumer's order to at least one merchant independently of action by the first consumer, the method comprising:

storing a first data store made up of data comprising a first consumer's purchase data;

storing a second data store made up of data comprising a second consumer's purchase data;

extracting the first consumer's purchase data from the database;

extracting the second consumer's purchase data from the database;

combining the first consumer's purchase data with the second consumer's purchase data;

anonymizing the purchase data from the first and second consumers' orders into anonymous data; and

transmitting the anonymous data to the at least one merchant wherein the combining and anonymizing steps are performed independently of any input from the first or second consumer.

23. The method of claim 22 wherein the anonymizing is performed with respect to the first and second consumers' credit card numbers.

24. The method of claim 22 wherein the anonymizing is performed with respect to the first and second consumers' identification data.